

P37034

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE OFFICE OF PETITIONS**

In re Patent Application of:
Cindy KOHANEK et al.

Application No.: 09/904,425

Confirmation No.: 1776

Filed: July 12, 2001

Art Unit: 2859

For: LINEARITY MEASURING APPARATUS FOR
WAFER ORIENTATION FLAT

Examiner: G. Bradley Bennett

Attorney Docket No.: P37034

SUPPLEMENTAL DECLARATION OF JULES E. GOLDBERG, ESQ.

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

I, JULES E. GOLDBERG, hereby declare and state as follows:

1. I have previously executed a Declaration of Jules E. Goldberg, Esq. (hereinafter Declaration), dated January 28, 2009, in connection with the above-identified application, and incorporate the contents of that Goldberg Declaration in full herein;
2. The above-identified Application No. 09/904,425 (hereinafter the '425 application) became abandoned during prosecution, and I believe for the reasons set forth herein that the failure to prosecute the application for its entire period of abandonment was unintentional. Moreover, immediately upon my becoming aware of the abandoned status of the '425

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application, on information and belief, I understand that steps were diligently undertaken to revive the application;

3. The '425 application was filed July 12, 2001, based upon instructions from the Japanese law firm of Suda Patent Office (hereinafter "SPO") through Mr. Masayoshi Suda, on behalf of the assignee as discussed in the Goldberg Declaration;

4. Instructions for prosecution of the '425 application were directly received from SPO, and all matters of prosecution of the '425 application were based upon these direct instructions from SPO;

5. On July 3, 2002, a first Office Action on the merits was mailed from the Patent and Trademark Office setting a three month shortened statutory period for response until October 3, 2002, and to which a response was inextendibly due with payment of extensions of time for three months by January 3, 2003;

6. In a letter to the Suda law firm of July 31, 2002, I advised Mr. Suda of the Office Action including its 3-month due date of October 3, 2002 and its 6-month due date of January 3, 2003 which could not be further extended;

7. A letter of instructions from SPO, dated September 12, 2002, was on information and belief forwarded to me from at the Reed Smith law firm; however, this letter does not appear in the file, a letter from SPO bearing the date of September 12, 2002, marked "URGENT REMINDER" appears in the file including the intentions of the applicants and the assignee to continue prosecution;

8. A letter of instructions from SPO, dated September 20, 2002, appears in the file requesting my response to the September 12, 2002 letter as well as the filing of a petition for a one month extension of time;

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9. A letter dated September 20, 2002 appears in the file from me to SPO in response to their request for instruction suggesting strategy for proceeding with the prosecution of the application, and indicating my desire to discuss the application with the Examiner;

10. My review of the file does not reveal any further correspondence with SPO;

11. Moreover, a review of the file reveals only one paper from the PTO after the receipt of the July 3, 2002 Office Action, i.e., a Notice of Publication mailed December 19, 2002.

12. The face of the file (a copy attached as Exhibit A) reveals "Petition to Revive" with mailed and filed dates indicated as "2-6-2003", "Awaiting Answer to Petition" with a date of "6-6-2003" and "Abandonment Recd" with a date of 3-26-2003. I did not make these entries and, on information and belief, these entries were made by the docketing department. However, a review of the file does not reveal the presence of a Petition to Revive or a Notice of Abandonment;

13. I have reviewed a copy of a Notice of Abandonment in connection with the '425 application that indicates a mailing date of March 26, 2003, and the indication:

"The Applicant's representative Mr. Jules E. Goldberg, was called this week of 3 FEB 2003. At the time, Mr. Goldberg had said that response would be mailed to the previous office action. However, as of 24 MAR 2003, no reply has been received. Therefore, the application is abandoned";

14. On information and belief, it appears that while the front Cover Page of the file reveals that a Petition to Revive has been filed with the PTO, it does not appear that a Petition to Revive has been received by the PTO in connection with the '425 application;.

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15. I do not presently recall a telephone conversation with the Examiner during the week of February 3, 2003, do not presently recall the abandonment of the '425 application, and cannot state why a Petition to Revive is not present in the PTO records or in the file when the face of the '425 application indicates the filing of a Petition to Revive. However, I can state that from any recollection that I have in connection with the '425 application, I had no reason to abandon the application, did not intend to abandon the application, and from my normal practice, would have intended to and taken all steps necessary for revival of the application. Thus, the abandonment of the application as well as the delay in reviving the application were not intentional;

16. Reed Smith uses a commercial database system known as "PATTSY" to manage the prosecution of applications including keeping track of due dates and the filing of papers before the U.S. PTO. The docketing department at Reed Smith, at the time of the abandonment of the '425 application, included three experienced persons whose duties included receiving and entry of papers from the U.S. PTO into the files, entry of papers into the docketing system, and communicating with attorneys regarding due dates. On information and belief, papers from the U.S. PTO are ordinarily properly placed of record in files, and follow up actions are thereafter taken based upon entry into docketing system. In the instant situation, despite the exercise of due care and diligence, on information and belief, errors were made upon entering the Notice of Abandonment and the Petition for Revival in the docketing system which led to the delay in becoming aware of the abandonment.

17. As previously indicated in my Goldberg Declaration, I agreed to present a Goldberg Declaration to the PTO in support of a Petition to Revive the '425 application, and have also agreed to submit this Supplemental Declaration. The original draft of this Supplemental Declaration was prepared by Greenblum and Bernstein, but I have thoroughly and completely reviewed the original draft Supplemental Declaration and have modified that original draft to be sure it states accurately, and in my own words or words with which I have complete comfort as if they were my own, what I would have written myself. Therefore, this Supplemental Declaration is the result of the modifications I made to the original draft provided by Greenblum and Bernstein that I have personally approved, signed, and present here as my own Supplemental Declaration;

18. In signing this Supplemental Declaration, I understand that the Supplemental Declaration will be filed as evidence in support of a Petition to Revive the '425 application; and

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I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge and understanding that willful false statements and the like so made are punishable by fine, or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any U.S. patents issued from such applications.

Respectfully submitted,

Dated:

10/23/09

JULES E. GOLDBERG

6: MSAD 1001

EXHIBIT A

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R. Cindy KOHANEK and Gary BABB

IO. 09/904,425

FILED July 13, 2001

PRIMARY FLAT LINEARITY GAUGE

E Mitsubishi Silicon Materials Silicon Corp.

IENT RECORDED March 11, 2002 REEL 012730 FRAME 0063

OFFICE ACTIONS	AMENDMENTS
P. Reed 8-29-2001	Expected July 11-29-2001/Deadline 2-28-2002
trial Del. 2-13-2002	Attache 8-13-2002
2-13-2002	
102 RCV	Oct. 3, 2002 Due / Jan. 3, 2003 Deadline
two to Review 2-6-2003	Continuing Answer to Petition 6-6-2003
2-6-2003	
informant rec'd 3-26-2003	

Y3079-00047 Folder: 0001



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Client: SUDA PATENT OFFICE

Matter: LINEARITY MEASURING APPARATUS FOR
WAFER ORIENTATION FLAT, SERIAL NO.
09/904,425 (SU-5072)

Folder: Y3079-00047

Billing: GOLDBERG, JULES

Notice RCV'd 10-11-2002

No. 15-2002-0189118-A1

Date: 10-19-2002

hgabdeTr

FINAL FEE PAID

IO. DATE

CLIENT OR TITLE
DIVISION OF
CONTINUATION IN PART OF

CANADIAN
INVENTOR

OTHER FOREIGN

15-54-5012

15-54-5072 Client Ref: M022705

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